

**REMARKS**

The present application has been carefully studied and amended in view of the outstanding Office Action dated December 19, 2005, and reconsideration of that Action is requested in view of the following comments.

Applicant respectfully traverses the restriction requirement particularly between the apparatus of claims 1-5 and 6 and the method of claims 8-10. All of these claims are properly classified in class 156 and the overall subject matter is closely related requiring similar and overlapping search. Similar issues must be addressed to determine patentability and it is therefore requested that the apparatus and method claims be examined in a single application. Discretion is allowed in these circumstances, and it is respectfully requested that such discretion be exercised in the present application by withdrawing the restriction between apparatus claims 1-5 and 7 and method claims 8-10. As required by the Rules, applicant respectfully confirms the provisional election to prosecute the apparatus invention, and finds claims 1-5 and 7 readable thereon.

Applicant respectfully submits that the subject matter of claims 1-5 and 7 is neither shown nor suggested by the prior art either taken alone or in combination with one another. Fundamentally these claims are not rendered obvious by the basic combination of Vijuk US 4,812,195 and Bahr et al US 4,425,181 ("Bahr"), for the reasons stated below. Also, Gunther et al US 4,071,997 ("Gunther") added to the Vijuk/Bahr combination in the rejection of claims 1-3, 5 and 7, and Joice US 4,275,997 added to the Vijuk/Bahr/Gunther combination in the rejection of claim 4 do not address the deficiencies of the basic Vijuk/Bahr combination.

It is abundantly clear that apparatus claims 1-5 and 7 recite a continuous roll of preprinted onserts together with a cutter constructed and arranged to cut individual onserts from the roll. These onserts are transported to a buckle folder for folding purposes, and in continuous fashion a transport system serially receives the folded onserts and moves them along diverging paths. Conveyors are constructed and arranged to receive onserts from the diverging paths, and applicators serially receive the folded inserts and apply them to consumer packs.

As explained in the specification in the paragraph at the top of page 2, in the prior art onserts are pre-folded and delivered for packing operations as stacks of individual pre-folded onserts. This is exactly what is disclosed in the Vijuk and Bahr references where onserts are automatically boxed at a discharge station 24 into a container 22 (Vijuk, column 4, lines 20-22), and where prepackaged onserts from a magazine 22 are picked up and applied to consumer containers 14 (Bahr, column 2, lines 63-65). The disadvantages of this approach involve the overall expense and difficulty of making and handling of pre-folded stacks of individual printed onsert material. Also, significant inventories are required, and the logistics involved are both extensive and time consuming. Individual onserts are difficult to handle at cigarette packaging machines that operate at extremely high production speeds in that the inserts tend to jam quite easily, and therefore require intensive operator intervention for feeding them from the magazines to applicators that deliver and apply the onserts to the cigarette packs. The present invention of claims 1-5 and 7 was developed to specifically address these past problems.

Bahr is representative of the prior art discussed in the present specification where prepackaged onserts are removed from storage magazines 22 and thereafter applied to product packs.

Vijuk on the other hand discloses an apparatus for producing onserts using a buckle folder, but the folded onserts are then packaged for use at a later time and place. It is significant that one of the main objectives of Vijuk is the "automatic boxing of the outserts, which may be coming off the equipment at rates of 42,000 outserts per hour into boxes without requiring a separate operation to box the outserts at the discharge end of the apparatus" (column 1, lines 45-49). Vijuk simply discloses an apparatus for producing the prepackaged magazines 22 of Bahr. Clearly the Vijuk/Bahr combination fails to suggest the in-line system of the present invention where onserts are cut from a continuous roll, folded, moved along divergent paths and conveyed to applicators that immediately apply the onserts to consumer packs without the need for prepacking an inventory of the onserts prior to application to the consumer packs.

Neither Gunther nor Joice address the above described deficiencies of the Vijuk/Bahr combination of prior art.

35 USC §103 requires that the claimed subject matter as a whole not be obvious to a person of ordinary skill in the art at the time the invention was made. This phrase guards against entering into the tempting, but forbidden zone of hindsight. Applicant respectfully submits that the Examiner is resorting to prohibited hindsight in the rejection of claims 1-5 and 7 while utilizing the present disclosure as a blueprint for the formulated rejection. While the Examiner may properly reject the claims in this application by showing a suggestion, teaching or motivation to combine the prior art, no

such suggestion, teaching or motivation exists in the prior art combination of Vijuk/Bahr relied upon in the rejection. Bahr includes a magazine 22 of prefolded onserts and Vijuk simply shows one way of producing such a magazine. Absent the present disclosure there is no such suggestion, teaching or motivation to make the combination as set forth in claims 1-5 and 7.

The prior art as a whole must suggest the desirability of making the combination. Two significant features must be considered. First, whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed apparatus, and second, whether the prior art would have also revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and reasonable expectation of success must be found in the prior art, not in applicant's disclosure. It is respectfully submitted that the present disclosure is the only suggestion for the recited prior art combination.

Even if the Examiner is successful in finding all of the claimed elements in the prior art, the issue is not whether each element is old or unpatentable, but instead whether there is something in the prior art as a whole to suggest the desirability of making the combination. Here again, there is no such suggestion in the prior art, and instead the prior art clearly requires a supply of prepackaged folded onserts.

Applicant respectfully submits that the Examiner must provide full reasoning as to what motivation or teaching in the prior art would suggest combining the references relied upon in the obviousness rejection. It is well established that the Examiner's general common knowledge and common sense do not substitute for the authority

required by law to reject a claim for obviousness. In re Sang-Su Lee, 61 USPQ 2d 1430 (CAFC 2002).

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the references without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make the modification, and hence the claimed invention, obvious unless the desirability of such modification is suggested by the prior art. In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992). Applicant disagrees with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at applicant's claimed invention. The Examiner's argument is clearly based on prohibited hindsight reconstruction.

In summary, obviousness cannot be established by combining the teachings of the applied prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination. In re Geiger, 2 USPQ 2d 1276 (Fed. Cir. 1987). Applicant respectfully submits that there is no reason for one skilled in the art to combine Vijuk/Bahr in the rejection of claims 1-5 and 7, and such rejection should be withdrawn. At best this combination shows a magazine of prepackaged inserts and fails to suggest the in-line features of the present invention where individual inserts are cut from a continuous roll, folded, moved along divergent paths, and conveyed to applicators that directly apply the onserts to consumer packs.

Also, with regard to the rejected claims the secondary Gunther and Joice references, it is abundantly clear that these references fail to suggest the structural features of the lug belt conveyor and the suction rail associated therewith as recited in claims 1, 4 and 7.

In view of the above argument, it is submitted that claims 1-5 and 7 are indeed patentable over the prior art, and it is respectfully requested that the rejection of these claims be withdrawn.

Respectfully submitted,

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